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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,336	04/25/2001	Joachim Manfred Bauer	DE920000021US1	7538

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EXAMINER
SMITH, PETER J

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/842,336	BAUER, JOACHIM MANFRED	
	Examiner	Art Unit	
	Peter J Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/25/01, 2/11/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: application filed on 4/25/2001, IDS filed on 2/11/2002, foreign priority application filed 10/30/2000.

2. Claims 1-13 are pending in the case. Claim 1 is an independent claim.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed limitation "computer program code portions" in claim 10 is considered indefinite, since the word "portions" does not clearly set forth the metes and bounds of the patent protection desired. Claim 11 depends on claim 10 and thus suffers the same deficiency.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Dependent claims 10 and 11, are directed toward "A computer program for execution in a data processing system" to perform various steps. As presently drafted, the claim reads on a computer program per se, which does not constitute statutory subject matter as prescribed under 35 USC §101. Applicant could easily render the claimed invention statutory by amending the preamble to recite "A computer program on a computer readable medium for execution in a data processing system". The language in the preamble, "for execution in a data processing system" does not render the claimed invention statutory because it in effect constitutes intended use. See MPEP §2106:

> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:
> (A) statements of intended use or field of use,

Therefore, the intended use language does not limit the claim, and cannot be given patentable weight or a cause for the preamble to be statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 5-6, 8-10, and 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Gonzalez et al. (hereinafter "Gonzalez"), US 6,204,782 B1 filed 9/25/1998.

Regarding independent claim 1, Gonzalez discloses a source string of a plurality of source characters encoded according to a source encoding scheme and converting the source string into a target string encoded according to mixed codepages comprising a plurality of sub-codepages in fig. 1-2, the abstract, and col. 2 lines 46-61. Gonzalez discloses associating a predetermined processing priority with each sub-codepage yielding a processing priority sequence and converting the characters strictly according to the priority sequence in fig. 1 and 4, col. 6 lines 3-14, and col. 11 lines 7-19.

Regarding dependent claim 3, Gonzalez discloses accessing the sub-codepages having the highest priority which has not yet been accessed for a character if the character has not been found in the current sub-codepage in fig. 7 and col. 15 line 32 – col. 17 line 46.

Regarding dependent claim 5, Gonzalez discloses that the priority sequence is dynamically changed from a standard to an individual setting before running the code conversion in fig. 5 and col. 13 lines 27-36.

Regarding dependent claim 6, Gonzalez discloses an installed program means for performing the steps of a method according to claim 1 in fig. 10 and col. 2 lines 62-65.

Regarding dependent claim 8, Gonzalez discloses a chip means comprising hardware circuits implementing at least parts of the steps of a method according to claim 1 in fig. 10 and col. 2 lines 62-65.

Regarding dependent claim 9, Gonzales discloses a chip according to claim 8 in fig. 10 and col. 2 lines 62-65.

Regarding dependent claim 10, Gonzales discloses computer program code portions for performing respective steps of the method according to claim 1 in fig. 10 and col. 2 lines 62-65.

Regarding dependent claim 12, Gonzalez discloses a computer readable program means for causing a computer to perform the method of claim 1 in fig. 10 and col. 2 lines 62-65.

Regarding dependent claim 13, Gonzalez discloses wherein the source encoding scheme is a Unicode encoding scheme in fig. 2 and col. 2 lines 46-48.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2, 4-7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez et al. (hereinafter "Gonzalez"), US 6,204,782 B1 filed 9/25/1998.

Regarding dependent claim 2, Gonzalez teaches that the code conversion is performed in an order according to a target list which prioritizes the target encodings in fig. 1 and 4, col. 6 lines 3-14, and col. 11 lines 7-19. Gonzalez teaches that the prioritization of the target list may be either a default preference, preference of the application, or preference of the client in fig. 5 and col. 12 line 41 – col. 13 line 54. Gonzalez does not specifically state that the priority sequence should be in order of highest probability to lowest probability. The Examiner believes a natural preferred order of the target list of Gonzalez would have the most probable character target encoding as the most preferred target encoding and the least probable character target

encoding as the least preferred target coding in the list sequence. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Gonzalez to have prioritized the target encoding sequence to have the most probable target encoding as the highest priority and the least probable target encoding as the lowest priority because this would have resulted in the fastest conversion from the Unicode sequence to the multiple encoding sequence because it would have resulted in the few conversion errors and would have resulted in the fewest loops through the flow diagram of fig. 7 of Gonzalez.

Regarding dependent claim 4, Gonzalez does not specifically teach that more than one character is processed by a single hardware instruction. Parallel processing yields obvious benefits in that more work is done in a given time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gonzalez to have created the claimed invention. It would have been obvious and desirable to have implemented a parallel processing algorithm to have processed more than one character in a single hardware instruction to have converted the source string faster.

Regarding dependent claim 7, Gonzalez does not specifically teach that the installed program is resident on an Internet server. Gonzalez does teach a computer network connection in fig. 10 which enables to Gonzalez to operate over a network medium like the Internet. The Internet is globally accessible by people of various nationalities speaking and writing a plurality of different languages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gonzalez to have operated on an Internet server to have provided character conversion services for the diverse Internet population.

Regarding dependent claim 11, Gonzalez does not specifically teach that the computer program is a browser program. Gonzalez does teach a computer network connection in fig. 10 which enables to Gonzalez to operate in a browser to communicate with other computers. The Internet is globally accessible by people of various nationalities speaking and writing a plurality of different languages. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gonzalez to have operated in a browser program to have provided character conversion services for the diverse Internet population.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mukaigawa et al., US 6,246,976 B1 filed 3/13/1998 discloses identifying a combination of a language and its character code system using an occurrence probability table describing for each character the probability that a character code occurs. Watanabe et al., US 6,346,990 B1 division of application filed 11/10/1997 discloses selecting a character from a plurality of code character conversion tables. Shakib et al., US 5,778,213 patented 7/7/1998 discloses multilingual storage and retrieval. Tye, US 6,055,365 filed 11/4/1997 discloses code point translation for computer text. Tang et al., US 5,784,071 patented 7/21/1998 discloses a content-based code converter. Hiura et al., US 6,754,694 B1 filed 2/28/2000 discloses a cross-platform architecture to handle international text in emails. Lim et al., US 5,689,723 patented 11/18/1997 discloses allowing single-byte character set and double-byte character set fonts in a double-byte character set code page. Brown et al., US 5,477,451 patented 12/19/1995 discloses translating text from a first source language into a second target language.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931 (571-272-4101 after 10/20/2004). The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792 (571-272-4090 after 10/20/2004). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
August 31, 2004

SANJIV SHAH
PRIMARY EXAMINER